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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Docket: ATM-2215-2

Appellants : Wilfried JUD et al.

Examiner : Monique Jackson

Serial No. : 10/083,110

Art Unit: 1773

Filed : 02/27/2002

For : STERILIZABLE COMPOSITE FILM

TRANSMITTAL LETTER

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Attached hereto, please find:

- (1) A Reply Brief (in triplicate) in response to Examiner's Answer dated February 2, 2007.

If any fees or additional fees are due upon the filing of this paper, please charge Deposit Account No. 06-1110. A duplicate of this Transmittal Letter is attached for such purpose.

Respectfully submitted,

April 2, 2007
Date

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REPLY BRIEF

Mail Stop Appeal Brief – Patents
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Sir:

Appellants hereby reply to a possible new ground of rejection in the new Examiner's Answer (dated February 2, 2007).

The Board of Appeals, on March 29, 2006, returned the Examiner's Amendment (dated November 3, 2005) to the Examiner on the ground (among others) that it contained a new ground of rejection, (i.e., obviousness based on Migliorini etc., in view of Brietler et al. of Claims 30, 34 and 38 to 45).

The new Examiner's Answer restricts such obviousness rejection to Claims 39 to 45 (as was the case in the Final Rejection). Nowhere in the new Examiner's Answer is it stated that there is a new ground of rejection. The new Examiner's Answer used from 12.179 conclusion that is for use when there is no new ground of rejection.

The undersigned attorney contacted the Examiner, who confirmed that the new Examiner's Answer did not contain any new grounds of rejection.

If there is a new ground of rejection (i.e., obviousness based on Migliorini et al. in view of Brietler et al.), appellants submit the following in response to such new ground of rejection.

(VII) ARGUMENT

The possible new grounds of rejection for consideration by the Board in this appeal is (a) Claims 30, 34 and 38 to 45 or (b) Claims 39 to 45 have been rejected as being unpatentable under 35 U.S.C. 103(a) over Migliorini et al. in view of Breitler et al. Appellants traverse such possible new ground of rejection.

In the new Examiner's Answer, the possible new ground of rejections failed to comply with the requirements of the Supreme Court's Graham decision as required by the Patent Office policy, and hence should be reversed.

The Graham decision states:

“Under § 103, ... and the level of ordinary skill in the pertinent art resolved.”

The language used by the Supreme Court is mandatory and is not merely permissive.

The policy of the Patent Office is that the Patent Office “is to follow Graham v. John Deere Co. in the consideration and determination of obviousness under 35 U.S.C. 103.” Hence, the Patent Office policy requires that the level of ordinary skill in the pertinent art be resolved.

Evidence that can be used in making such resolution is not the same as actually making such mandatory resolution. Nowhere has the Examiner resolved the level of ordinary skill in the record. Rule 1.2 requires that the action of the Patent Office will be based exclusively on the written record in the Patent Office.

Appellants have been denied their right (if there is a new ground of rejection) to rebut the Patent Office's resolution of the ordinary level of skill in the pertinent art because any such resolution by the Patent Office does not exist in the record.

Reversal of the possible new ground of rejection is respectfully requested.

Respectfully submitted,

April 2, 2007
Date

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